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EXAMINER

CHIANG, JACK

ART UNIT PAPER NUMBER

2642

DATE MAILED: 07/06/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/070,890

Applicant(s)

Heinrichshofen et al.

Examiner

O. Chiang

Group Art Unit

2642

#6

--The MAILING DATE of this communication appears on the cover sheet beneath the correspondence address--

Period for Response

A SHORTENED STATUTORY PERIOD FOR RESPONSE IS SET TO EXPIRE -3- MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a response be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for response specified above is less than thirty (30) days, a response within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for response is specified above, such period shall, by default, expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to respond within the set or extended period for response will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).

Status

- ☒ Responsive to communication(s) filed on 3-6-02.
- ☐ This action is **FINAL**.
- ☐ Since this application is in condition for allowance except for formal matters, **prosecution as to the merits is closed** in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

Disposition of Claims

- ☒ Claim(s) 13-25 is/are pending in the application.
- Of the above claim(s) _____ is/are withdrawn from consideration.
- ☐ Claim(s) _____ is/are allowed.
- ☒ Claim(s) 13-25 is/are rejected.
- ☐ Claim(s) _____ is/are objected to.
- ☐ Claim(s) _____ are subject to restriction or election requirement.

Application Papers

- ☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.
- ☐ The proposed drawing correction, filed on _____ is ☐ approved ☐ disapproved.
- ☐ The drawing(s) filed on _____ is/are objected to by the Examiner.
- ☐ The specification is objected to by the Examiner.
- ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119 (a)-(d)

- ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).
- ☒ All ☐ Some* ☐ None of the CERTIFIED copies of the priority documents have been received.
- ☐ received in Application No. (Series Code/Serial Number) _____.
- ☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

*Certified copies not received: _____

Attachment(s)

- ☒ Information Disclosure Statement(s), PTO-1449, Paper No(s). _____
- ☒ Notice of References Cited, PTO-892
- ☐ Notice of Draftsperson's Patent Drawing Review, PTO-948
- ☐ Interview Summary, PTO-413
- ☐ Notice of Informal Patent Application, PTO-152
- ☐ Other _____

Office Action Summary

DRAWINGS

1. The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, the "... wheel... a latching..." called for in **claim 17**, "... wheel ... with a stop." called for in **claim 19** must be shown or the feature(s) canceled from the claim(s). No new matter should be entered.

Corrected drawing sheets are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as "amended." If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. The replacement sheet(s) should be labeled "Replacement Sheet" in the page header (as per 37 CFR 1.84(c)) so as not to obstruct any portion of the drawing figures. If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

CLAIMS

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

3. Claims 13-18, 20-21 are rejected under 35 U.S.C. 102(e) as being anticipated by Pruchniak (US 6075518).

Regarding claim 13, Pruchniak shows an input device comprising:

Two rotary functions (rotary functions of 50) in opposition directions;

Two key functions (functions of 34) which can be triggered by a movement in a plane which is substantially perpendicular to a plane of the rotary movement;

An actuator wheel (52) which is supported axially on a bearing (54, 20) so that tilting movement of the wheel (52) out of the plane of the rotary movement on both sides is made possible.

Regarding claim 21, Pruchniak shows an input device comprising:

Two rotary functions (rotary functions of 50) in opposition directions;

Two key functions (functions of 34) which can be triggered by a movement in a plane which is substantially perpendicular to a plane of the rotary movement;

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An actuator wheel (52) which is supported axially on a bearing (54, 20) so that tilting movement of the wheel (52) out of the plane of the rotary movement on both sides is made possible; and

A display device (see fig. 6).

Regarding claims 14-18, 20, Pruchniak shows:

The key functions are implemented by one of pressing and tilting functions (see 34);

The bearing is a ball bearing (see 54; or structure around area 22);

Two sensors (see 34) for tilting movement;

A further sensor (60, 64) for rotary movement;

The wheel (52) rotates in one of a latching and a non-latching/freely running fashion.

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claim 19 is rejected under 35 U.S.C. 103(a) as being unpatentable over Pruchniak in view of Rosenberg et al. (US 6128006).

Regarding claim 19, Pruchniak shows the wheel (52).

Pruchniak differs from the claimed invention in that it does not show a stop.

However, Rosenberg teaches providing a stop for the wheel (col. 21, lines 33-38).

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Hence, it would have been obvious for one of ordinary skill in the art to modify Pruchniak with a stop on the wheel as taught by Rosenberg, such that to stop further scrolling when certain conditions are met (col. 21, lines 33-38).

6. Claims 22-23 are rejected under 35 U.S.C. 103(a) as being unpatentable over Pruchniak in view of Whitmore (US 6108277).

Regarding claims 22-23, Pruchniak shows a display (fig. 6).

Pruchniak differs from the claimed invention in that the display does not have a substantially circular area, and items are arranged substantially along a circle.

However, it is commonly seen that various electronic devices have displays in various forms and shapes. Whitmore shows a substantially circular display having items displayed in substantially along a circle (see 40 in Fig. 1).

Hence, it would have been obvious for one of ordinary skill in the art to adapt Pruchniak's input device in any electronic devices, including the Whitmore's environment which has a substantially circular display. This simply can be considered as an intended use of Pruchniak, as it is understood that today's electronic devices usually have the combination of input device and display.

7. Claims 24-25 are rejected under 35 U.S.C. 103(a) as being unpatentable over Pruchniak in view of Iijima et al. (US 6359668).

Regarding claims 24-25, Pruchniak shows the combination of a display and a communication device (fig. 6).

Pruchniak differs from the claimed invention in that it does not explicitly mention that the display have at least two colors and the device is a phone.

However, Iijima shows a display having colors and its application on various electronic devices, including a phone (figs. 30a-c).

Hence, it would have been obvious for one of ordinary skill in the art to modify Pruchniak's display with the type of Iijima's color display (col. 22, lines 12-24 in Iijima), this modification would produce an electronic device having a bright display (col. 4, lines 10-18 in Iijima). Further, the application of the combination in the phone environment is also shown by Iijima (figs. 30a-c in Iijima).

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jack Chiang whose telephone number is 703-305-4728. The examiner can normally be reached on Mon.-Fri. from 8:00 to 6:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ahmad Matar, can be reached on 703-305-4731. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.


Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should

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you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Jack Chiang
Primary Examiner
Art Unit 2642